

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:

Peter J. SHANK *et al.* Confirmation No. 4334

Application/Control No.: 10/720,176 Group Art Unit: 3774

Filed: November 25, 2003 Examiner: Yashita Sharma

For: COMPOSITE STENT WITH INNER AND
OUTER STENT ELEMENTS AND METHOD
OF USING THE SAME

REQUEST FOR RECONSIDERATION

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

Appellants respectfully request reconsideration of the Decision on Appeal (“the Decision”) decided December 18, 2008.

Appellants request reconsideration of the Decision mailed December 18, 2008, affirming the Examiner’s rejection of claims under 35 U.S.C. §102(e) for allegedly being anticipated by Hossainy.

At page 12 of the Decision, the Board alleges, among other things, that Hossainy disclosed an “...outer covering that can be configured as a sleeve that can be configured as a sleeve or tube that exerts sufficient force to avoid collapsing when subjected to compressive forces.....”. However, it is respectfully submitted that this is in error, because there would be no requirement that the sleeve be compression fitted as disclosed by Hoassainy if it could support

itself as a stent. Clearly, Hossainy relies on support of the inner structure to support this tube or sleeve.

This is further supported by Hossainy at col. 3, ll. 44-49, which, as set forth in the Decision at page 11, last line of first full paragraph, describes that the restoring force “avoids collapsing or substantially deforming an expanded stent over time.” This disclosure does not provide indication that the outer covering could stand alone without inner support.

Thus, Hossainy does not disclose a composite stent having a separate outer stent, and none of the claims are anticipated by Hossainy under 35 U.S.C. §102(e).

Furthermore, although claim 23 was cited in the Decision as a representative claim, the Decision is devoid of any discussion of the interpretation of the feature in claim 23 requiring the self-expanding metal stent to be “releasably engageable” within a bioabsorbable stent. Furthermore, in contrast to the assertion that Appellants have not argued and therefore concede that Hossainy meets the limitations in claim 23 directed to the inner metal stent (Decision, page 8, first full par.), and therefore waived any argument, Appellants have consistently argued that Hossainy does not disclose any inner stent. Attention is drawn to page 11 of the Appeal Brief, where Appellants do in fact argue that Hossainy does not disclose an inner stent, as it is argued that Hossainy discloses a single stent structure in Figures 2 and 3. The Examiner also failed to assert Figure 1 as anticipating the claimed subject matter. Thus, contrary to page 8, first full paragraph of the Decision, Appellants have in fact argued and have not conceded that Hossainy meets the limitations of claim 23 directed to the inner metal stent.

With particular respect to claim 23, as set forth at page 11, second full paragraph of the Decision, the Board argues that: “...Hossainy discloses that the outer covering of its device can

be configured as a tube (“compression fitted sleeve”....)....”. (underlining added). This interpretation is in direct conflict with the feature recited in claim 23 which provides that the self-expanding metal stent be releasably engageable within the bioabsorbable stent. Appellants submit that if Hossainy’s tube (outer covering) is compression-fitted, then Hossainy’s stent 100 cannot be releasably engageable within Hossainy’s bands 209 or disclosure of a compression fitted sleeve are interpreted as an outer stent, nothing in Hossainy discloses that the outer stent is releasable engageable from the inner stent.

In view of the foregoing a favorable decision is requested on Appellants Request for Reconsideration. Any necessary fees to enter this Request or to maintain pendency of this application may be charged to deposit account 50-0624.

Date: January 28, 2009

Respectfully submitted,

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